THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ORRIN D. CHRISTY, JOHN E. PICKETT,
MARK A. MATHEIS and LEO SWANSON

Appeal No. 95-4570
Application No. 08/047,188[1]

ON BRIEF

Before KIMLIN, JOHN D. SMITH and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-22, all the claims remaining in the present application. Claim 1 is illustrative:

1. A method of applying a designated, non-primary color print to a substrate, comprising the steps of:

---

[1] Application for patent filed April 16, 1993.

(a) making at least first and second differently colored toner powders having substantially uniform physical characteristics;

(b) introducing the first and second toner powders in desired proportions into a fluidized bed;

(c) uniformly mixing the first and second toner powders together in the fluidized bed;

(d) applying a substantially uniform electrostatic charge to the toner powders in the fluidized bed; and

(e) applying the electrostatically charged mixture of toner powders to a substrate to form uniform non-primary color symbols on the substrate.

The examiner relies upon the following references as evidence of obviousness:

Fotland et al. (Fotland)	4,777,106	Oct. 11, 1988
Christy et al. (Christy)	5,532,100	July 2, 1996 (filed Jan. 9, 1991)

Appellants' claimed invention is directed to a method of applying a non-primary color print to a substrate utilizing electrostatic imaging technology. The method entails introducing first and second differently colored toner powders having substantially uniform physical characteristics into a fluidized bed, uniformly mixing the toner powders and applying a substantially uniform electrostatic charge to the mixed powders, and applying the electrostatically charged mixture to a substrate. According to appellants, whereas it has been difficult in the past to apply a uniform charge to a mixture of

toner powders of different color, the present invention is able to apply a uniform charge to the differently colored powders by selecting differently colored powders having substantially the same physical characteristics, such as resistivity, particle size and flowability.

Claims 1-22 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-28 of U.S. Application No. 07/639,360, now U.S. Patent No. 5,532,100. Claims 1-22 also stand provisionally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,532,100. In addition, appealed claims 1-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fotland.

Upon careful consideration of the opposing arguments presented on appeal, we agree with appellants that the examiner's rejections are not sustainable.

We consider first the rejections under obviousness-type double patenting and 35 U.S.C. § 102(e) over claims 1-28 of U.S. Patent No. 5,532,100. The present claims on appeal recite the positive steps of uniformly mixing first and second differently colored toner powders and applying a substantially uniform electrostatic charge thereto. Neither the claims nor the disclosure of U.S. Patent No. 5,532,100 describes or suggests

these claimed steps. Manifestly, there is no factual support for the examiner's conclusion that the appealed claims are described by the patent within the meaning of 35 U.S.C. § 102, or rendered obvious for purposes of obviousness-type double patenting by claims 1-28 of the patent. While the examiner states that "[t]he issue of toner color is not patentably distinct" (page 7 of Answer), the issue properly argued by appellants is that U.S. Patent No. 5,532,100 fails to describe or suggest the claimed steps of uniformly mixing and charging first and second differently colored toner powders.

Likewise, Fotland provides no teaching or suggestion of the claimed steps of uniformly mixing and charging first and second differently colored toner powders. Fotland's only mention of colored toners is in the cautionary statement that "conductive toners can limit printing quality when colored toners are utilized" (column 1, lines 32 and 33). While the examiner reasons that "toners having uniform physical characteristics would be expected to perform similarly in a charged fluidized bed and the associated method of applying toner" (sentence bridging pages 5 and 6 of Answer), the reference provides no teaching or suggestion of uniformly mixing and charging toners of different color having uniform physical characteristics. At best, the

examiner invokes impermissible hindsight as a basis for the rejection.

In conclusion, based on the foregoing, we are constrained to reverse the examiner's rejections.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
JOHN D. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CHUNG K. PAK Administrative Patent Judge	)	

Nixon and Vanderhye
1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714